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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKENORI KOHDA, TERUO KOYANAGI,
and KEN MASUMITUS

Appeal 2007-4076
Application 09/855,281¹
Technology Center 2100

Decided: June 5, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed May 15, 2001. Appellants claim the benefit under 35 U.S.C. § 119 of Japan application 2000-197368, filed 06/26/2000. The real party in interest is International Business Machines Corporation.

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 22 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method for guiding users to advertising or advertisers' web pages on the Internet. In the words of the Appellants:

It is, therefore, one object of the present invention to provide means for guiding a user to specific site groups, regardless of whether or not the user has an interest in the materials available thereat.

It is another object of the present invention to provide a moving object for traveling within a specific site group in order to guide a user to that site group.

To achieve these objects, according to the present invention, a user guidance method characterized by the following configuration is provided. The user guidance method comprises the steps of: permitting an object, which is so defined that it can be obtained by a user, to appear at a specific location of a specific site; and moving the object, whereby a user who desires to obtain the object is guided to predetermined content available at the specific site.

(Spec., 2, middle).

Claim 1 is exemplary:

1. A user guidance method performed on a computer comprising the steps of:

incorporating an object into a specific web site at a specific location, wherein the object is capable of being selected by a user in order to provide a reward for the user; and

moving the object from the specific location to a different location,

whereby at least one user desiring to select the object is guided to predetermined content available at the specific web site.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Miles	US 6,102,406	Aug. 15, 2000
Kay	WO 0041067	Jul. 13, 2000

Rejections:

R1: Claims 16, 17, and 20 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

R2: Claims 1 to 22 stand rejected under 35 U.S.C. § 103(a) for being obvious over Miles in view of Kay.

Appellants contend that claims 16, 17, and 20 are statutory because the limitations are performed on a computer. They further contend the claimed subject matter is not rendered obvious by Miles in combination with Kay, as the combination of references should not be combined, and even if

combined, they do not teach the limitations of the claims. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2006).²

We affirm.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the noted claims under 35 U.S.C. §§ 101 and 103(a) respectively. The issues under 35 U.S.C. § 101 concern whether claims 16 and 17 properly recite “an object management means” which is supported by recited hardware in the specification; and whether claim 20 is drawn to non-functional descriptive material. The issue under 35 U.S.C. § 103 addresses

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

whether Miles and Kay are properly combined, and whether they teach the elements of the claims.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

We note our reviewing court has recently reaffirmed that:

an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. . . . In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006) (emphasis in original).

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

“The long-recognized problem with a single means claim is that it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor. See *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 112, 14 L.Ed. 601 (1853). Thus,

the claim is properly rejected for what used to be known as “undue breadth,” but has since been appreciated as being, more accurately, based on the first paragraph of § 112.” *In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. §§ 101 and 103. The prima facie cases are presented on pages 3 to 16 of the Examiner’s Answer.

Rejections under 35 U.S.C. § 101(R1)

Claims 16 and 17 have been rejected by the Examiner for being non-statutory. The Examiner objects to the claim including the phrase “‘...an object management means’ which is not defined either in the claim or in the specification as including hardware.” (Ans., 3, bottom). Without the recitation of some hardware, she contends, claim 16 and dependent claim 17 are not limited to tangible embodiments. Appellants argue that the limitations are performed on a computer, which, even if true, does not obviate this rejection as the computer is not recited. Though we appreciate the lack of recitation of hardware, we do not agree with the Examiner that a rejection under 35 U.S.C. § 101 is the proper rejection for these claims, and thus will reverse this rejection of these claims in favor of the treatment below.

The Examiner further contends that “With respect to claim 20, the language of the claim appears to be drawn to non-functional descriptive material. An ‘object’ as recited in claim 20 is data, per se, lacking any functionality.” We will support this rejection as the claimed “moving object” as expressed does not perform any function, but exists only as a software construct being acted upon. The claim, therefore, has no tangible structure, and the only object performs no function, so it does not qualify as patentable subject matter. *See In re Comiskey*, 499 F.3d 1365, 1377 (Fed. Cir. 2007).

Rejections under 35 U.S.C. § 103(R2)

Appellants first contend that there is no demonstrated motivation to combine the Miles and the Kay references. (App. Br., 7, bottom). In accordance with the guidance of *KSR Int’l v. Teleflex Inc.* (cited above) and *In re Clay* (cited above) we note that both references are from the same field of endeavor (i.e., directing an Internet user to an advertising site). We thus hold that the combining of these references is proper.

Claims 1 to 8, 16 and 17, 20

Appellants next focus on the content of the references, arguing that the combination of Miles and Kay fails to teach moving the object from the specific location to a different location. (App. Br., 10, middle). From the discussion surrounding Figures 12 and 13 (Spec. page 28, bottom; page 29,

bottom) we see that in the context of this application, “moving of the object” does not mean that the object moves around a web page with simulated animation, but rather that the object appears on one web page, then appears on another web page. (*Id.*). In the reference Kay we find that the special objects (#6, #9 or #10 in Figures 2A, 2B or 2C) are taught as appearing on various web sites. In a similar vein, the Miles reference teaches a scavenger hunt in which special objects are hidden in various vendor’s web pages, and users desiring to select the object (to claim a reward) are guided to the web sites. We find that the Miles reference itself teaches the “movement” of the special objects, as understood in the sense of the application, sufficiently as claimed, since the object appears in a series of web pages to be found by the user in accordance with the clues and prompts provided. Kay does add the special teaching of the object being placed on various types of web pages for advertising purposes. We thus agree with the Examiner that the references present sufficient teachings to render the claims obvious.

Claims 9 to 11

Appellants contend that “[t]he combination of Miles and Kay fails to disclose an object manager that manages the location and movement of an object on a network and arranges the object at a desired location to guide the user to the desired content on the network...”. (App. Br., 11, middle). We agree with the Examiner’s response (Answer, page 21) and find no error with this rejection.

Claims 12 to 15

Appellants contend “[t]he combination of Miles and Kay fails to disclose a main server that incorporates the object into a first web page and removes the object from a second web page.” The claim requires that an object may appear and disappear from one page, as no causal relationship between the appearance on one page and the disappearance from another page is claimed. In Kay, page 6, line 17, is taught the appearance and disappearance of the object from a web page. We do not see error in using that teaching with that of Miles to reject the claims for being obvious over the cited art.

Claims 18 and 19, 21, and 22

With regard to claims 18 and 19, Appellants contend, “Under the control of the object position management means the link setting means changes a target web page for setting a link thereto. The combination of Miles and Kay fails to disclose a link setting means for setting a link in a web page to move the object.” (App. Br., 12, middle). As the Examiner mentions (Ans., 13, bottom), we find that Miles teaches a central position management system (Column 13, lines 55 to 63) that places the object in a series of web pages, as stored in tables #34 and #36. The apparent movement of the object is controlled by the series of links to the advertisers’ sites, as described in the patent. We do not find error in a rejection of these claims over the cited art.

With regard to claims 21 and 22, both Miles and Kay teach the execution of their respective embodiments on a computer system (e.g. Miles, Figure 3, #24). We find that programs are inherently stored on storage media in such computer systems. The processes for incorporating the specific objects into web pages as claimed are taught by Kay (e.g., page 4, lines 9 to 18) and Miles (col. 9, lines 22 to 28).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 16 and 17 under 35 U.S.C. § 101. We further conclude that the Examiner did not err in rejecting claim 20 under 35 U.S.C. § 101 for being non-statutory. We also conclude that the Examiner did not err in rejecting claims 1 to 22 under 35 U.S.C. § 103 as specified in rejection R2.

OTHER ISSUES

REJECTION OF CLAIMS 16 AND 17 UNDER 37 C.F.R. § 41.50(B)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

Rejection:

Claims 16 and 17 are rejected under 35 U.S.C. § 112 (1) for being expressed as single means claims, consistent with the holding of *In re*

Hyatt, (quoted and cited above). Claim 16 specifies a single means, the object management means, and no other qualified element, and thus does not present an enabling disclosure commensurate with the scope of the claim being construed. The “object to be embedded” mentioned in the claim is simply a data arrangement with no tangible structure. The claim does not qualify as a proper means plus function claim under the express statutory exception of 35 U.S.C. § 112 (6), as that section requires a combination, not a single means. As claim 17 merely embellishes the function of the same single means, it does not obviate the rejection. Since the claims do not satisfy the requirements of 35 U.S.C. § 112 (6) they are subject to rejection under 35 U.S.C. § 112 (1) for insufficient support in the Specification.

DECISION

The Examiner's rejection of claims 16 and 17 is reversed. The rejection of claim 20 under 35 U.S.C. § 101 for being non-statutory is affirmed. The rejection of claims 1 to 22 under 35 U.S.C. § 103(a) for being obvious over Miles in view of Kay is affirmed. Moreover, we have entered a new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 16 and 17 as failing to have sufficient support in the Specification as required by 35 U.S.C. § 112 (1).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Regarding the affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board." Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment, or a second appeal, this

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case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

rwk

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